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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Office Action Summary	**Application No.**	**Applicant(s)**
		09/870,296	NASHIDA ET AL.
		Examiner	**Art Unit**	
		FARZANA HOSSAIN	2424	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>22 October 2009</u>.
2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) <u>1,2,4-6 and 8-11</u> is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1,2,4-6 and 8-11</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>30 May 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a) ☒ All　b) ☐ Some * c) ☐ None of:
　　　　1. ☒ Certified copies of the priority documents have been received.
　　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.
　　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)　Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)　Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)　　　　　　　　　**Office Action Summary**　　　　　　Part of Paper No./Mail Date 20091223

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/22/2009 has been entered.

Response to Amendment

2.   This office action is in response to communications filed 10/22/2009. Claims 1,

2, 4-6, and 8-11 are pending. Claims 1, 4 and 8-11 are amended. Claims 2, 5 and 6

have been previously presented. Claims 3 and 7 are cancelled.

Response to Arguments

3.   Applicant's arguments filed 10/22/2009 have been fully considered but they are

not persuasive.

Regarding Claim 1, the applicant argues that Kuroda does not teach a) determining a failure in the local storage means and b) issuing a recording substitution request to an external device via a wide area network in response to determination of failure (pages 8-9). The applicant argues that Kuroda teaches determining if capacity is sufficient not whether the recording system has failed (Page 10). The applicant argues that Ellis disclose a remote media server records programs in response to record requests and the combination does not disclose a) determining a failure in the local storage means and b) issuing a recording substitution request to an external device via a wide area network in response to determination of the failure (Pages 10-11). The applicant argues that a combination would merely suggest when capacity is insufficient and generate a warning to select another storage device and in addition indicate which program is to record (Page 11).

In response to the arguments, the examiner respectfully disagrees. Kuroda discloses determination means for determining a failure in the local storage means or based on lack of storage space the storage means fails to record the program requested to be recorded and/or reserved (Column 5, lines 60-65); means for issuing a recording substitution request to an external device for recording the program via the connection means in response to the determination means determining the failure (Figure 22, Figure 7). The broadest reasonable interpretation of the word failure includes lack of storage space as it fails to record in the selected storage device. Kuroda does not disclose that the external device is over a wide area network. Ellis discloses connection means for connecting via a wide area network with an external

device which is external to the recording system (Page 6, paragraphs 0084, Page 4,

paragraphs 0065, Figures 2c, 2d, 24, 20), means for issuing a recording request to the

external device for recording the program via the wide network by the connection

means (Page 6, paragraphs 0084-0085, Page 4, paragraphs 0065, Figures 2c, 2d, 24,

20). Kuroda discloses the recording substitution request is issued to an external device

(the warning is displayed to a user but another request is issued to an external device

for recording the program) (Figure 7, Figure 22) and combined with Ellis, the

combination discloses that the external device can be an external device over a wide

area network.

4.   Regarding claims 4-6 and 9, the applicant argues that Kuroda, Ellis and Zigmond

doe not disclose a first storage means for recording programs and a second storage

means for storing customized program content including a record program and

advertising information inserted or substituted in a recorded program (Page 11). The

applicant argues that Ellis merely teaches a remote server and does not teach

recording substitution request or a second storage means for storing customize

program content recording substitution means is configured to one of a) stores the

advertising information in the storage means as an insert in a recorded program stored

in the storage means in addition to original commercial information included in the

recorded program and b) stores the advertising information as a substitute for the

original information in the recorded program (Page 11-12). The applicant argues

Zigmond does not teach storing advertising information in a storage means.

In response to the argument, the examiner respectfully disagrees. The applicant argues that the limitation is customized program content including a recorded program and advertising information inserted into the recorded program or substituted for the original commercial information. The actual limitation is customized program content – which can be broadly interpreted as advertising content as that includes customized program content. Zigmond discloses recording substitution portion (ad insertion device performing ad insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a) stores a recorded program in the first storage means (Column 14, lines 9-11) and the advertising information in the second storage means (Figure 5, 82), the advertising information stored as an insert in the recorded program in addition to original commercial information included in the recorded program as only obsolete ads will be replaced (Column 14, lines 1-12) and b) stores the recorded program stored in the first storage means (Column 14, lines 9-11) and the advertising information as a substitute (Column 15, lines 31-34) for the original information in the recorded program stored in the storage means (Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines 1-12). Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); first storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with external devices (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2); recording substitution means for

responding to the reception of a recording substitution request from at least one of the

external devices via the connection means for receiving and recording means for

issuing a recording substitution request to an external device for recording the program

via the connection means (Figure 22, Figure 7). Ellis discloses connection means for

connecting via a wide area network with an external device which is external to the

recording system (Page 6, paragraphs 0084, Page 4, paragraphs 0065, Figures 2c, 2d,

24, 20), means for issuing a recording request to the external device for recording the

program via the wide network by the connection means (Page 6, paragraphs 0084-

0085, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20).

5.   Regarding Claim 8, the applicant argues Kuroda discloses a time-shift record but

does not teach a) determining a failure in the local storage means and b) issuing a

recording substitution request to an external device via a wide area network in response

to determination of the failure (Pages 13-14).

        In response to the arguments, Kuroda discloses determination means for

determining a failure or based on lack of storage space the storage means fails to

record the program requested to be recorded and/or reserved (Column 5, lines 60-65);

means for issuing a recording substitution request to an external device for recording

the program via the connection means in response to the determination means

determining the failure (Figure 22, Figure 7). The broadest reasonable interpretation of

the word failure includes lack of storage space as it fails to record in the selected

storage device. Kuroda does not disclose that the external device is over a wide area

network. Lawler discloses the issue portion for automatically issuing a recording

request to the external storage device for recording the program via the wide network by

the connection means (Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36).

6.   The applicant argues that Claims 10 and 11 depend from independent claims 1

and 8 and therefore are allowable.

        See response above.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kuroda (US 6,311,011) in view of Ellis et al (US 2003/0149988 and hereafter referred to

as "Ellis").

        Regarding Claim 1, Kuroda disclose a recording system for recording and/or

reserving a program (Figure 1) and a recording substitution system for substitutionally

recording a program (Figure 1), comprising:

means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); local storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105);

connection means for connecting with an external device (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2);

determination means for determining a failure in the local storage means or based on lack of storage space the storage means fails to record the program requested to be recorded and/or reserved (Column 5, lines 60-65);

means for issuing a recording substitution request to an external device for recording the program via the connection means in response to the determination means determining the failure (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the storage means or the external device.

Kuroda is silent for connection means for connecting via a wide area network with an external device which is external to the recording system, means for issuing a recording request to the external device for recording the program via the wide network by the connection means.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for

recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection

means for connecting via a wide area network with an external device which is external

to the recording system (Page 6, paragraphs 0084, Page 4, paragraphs 0065, Figures

2c, 2d, 24, 20), means for issuing a recording request to the external device for

recording the program via the wide network by the connection means (Page 6,

paragraphs 0084-0085, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify Kuroda to include connection means for connecting via a wide area

network with an external device which is external to the recording system (Page 6,

paragraphs 0084, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20), means for issuing

a recording request to the external device for recording the program via the wide

network by the connection means (Page 6, paragraphs 0084, Page 4, paragraphs 0065,

Figures 2c, 2d, 24, 20) as taught by Ellis in order to provide make it convenient for users

to play programs on demand instead of the users having to wait for a previously

scheduled program to possibly repeat at a time scheduled by the provider (Page 1,

paragraphs 0009-0011) as disclosed by Ellis.

Furthermore, in *KSR International Co. Teleflex Inc.*, 82 USPQ2d 1385, 1395

(2007), the Court found that if all the claimed elements are known in the prior art then

one skilled in the art could have combined the elements as claimed by known methods

with no change in their respective functions, and the combination would have yield

predictable results to one of ordinary skill in the art at the time of the invention.

Regarding Claim 2, Kuroda and Ellis disclose all the limitations of Claim 1.
Kuroda discloses the determination means generates a negative result when a
remaining capacity of the storage means is not sufficient for recording a broadcast
program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

9.   Claims 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Kuroda in view of Ellis and Zigmond et al (US 6,698,020 and hereafter referred to
as "Zigmond").

Regarding Claim 4, Kuroda disclose a recording system for recording and/or
reserving a program (Figure 1) and a recording substitution system for substitutionally
recording a program (Figure 1), comprising: means for accepting a request to record
and/or reserve a program (Column 4, lines 18-50); first storage means for recording a
program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting
with external devices (Column 4, lines 38-44, Column 5, lines 60-65); means for
receiving a program (Figure 1, Figure 2); recording substitution means for responding to
the reception of a recording substitution request from at least one of the external
devices via the connection means for receiving and recording means for issuing a
recording substitution request to an external device for recording the program via the
connection means (Figure 22, Figure 7).

Kuroda discloses recording substitution means or the recorder/player for
responding to reception of a recording substitution request via connection means and
receiving and recording a corresponding in the storage means (Column 5, lines 60-65,

Figure 7). Kuroda discloses the recording system or recording substitution system receives and records television programs in the first storage means or the external device, which necessarily includes commercials.

Kuroda is silent on second storage means for storing customized program content, user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and recording substitution means is configured to one of a) stores the advertising information in the storage means as an insert in a recorded program stored in the storage means in addition to original commercial information included in the recorded program and b) stores the advertising information as a substitute for the original information in the recorded program. Kuroda is silent for connection means for connecting via a wide area network with external devices which is external to the recording system, means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the wide network by the connection means and for receiving and recording a program corresponding to the request in the storage means.

In analogous art, Ellis discloses means for accepting a request to record and/or reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection means for connecting via a wide area network with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or

program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the wide network by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20).

   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include connection means for connecting via a wide area network with external devices which is external to the recording system including remote media server for recording programs, television distribution facility for distributing television, program, advertisements, video and/or program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from at least one of the external devices via connection means for receiving and recording the program via the wide network by the connection means and for receiving and recording a program corresponding to the request in the storage means (Page 6, paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20) as taught by Ellis in order to provide make it convenient for users to play programs on demand instead of the users having to wait for a previously scheduled program to possibly repeat at a time scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

The combination is silent on second storage means for storing customized program content; user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area network by the connection means and the recording substitution means or ad insertion device configured to one of a) stores a recorded program in the first storage means and the advertising information in the second storage means, the advertising information stored as an insert in the recorded program in addition to original commercial information included in the recorded program as only obsolete ads will be replaced and b) stores the recorded program stored in the first storage means and the advertising information as a substitute for the original information in the recorded program stored in the storage means.

In analogous art, Zigmond discloses connection means to external devices (Figure 4, 62, 66, Column 9, lines 39-55); first storage means for recording the program (Column 14, lines 9-11); second storage means for storing customized program content (Figure 5, 86, Column 13, lines 38-57, Column 15, lines 25-30); user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin from another external device or advertising source via the wide area network by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55, Column 14, lines 4-6) and the recording substitution means or ad insertion device (Figure 5, 80, 86, 83, 82, 81).

Zigmond discloses recording substitution portion (ad insertion device performing ad

insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34)

configured to one of a) stores a recorded program in the first storage means (Column

14, lines 9-11) and the advertising information in the second storage means (Figure 5,

82), the advertising information stored as an insert in the recorded program in addition

to original commercial information included in the recorded program as only obsolete

ads will be replaced (Column 14, lines 1-12) and b) stores the recorded program stored

in the first storage means (Column 14, lines 9-11) and the advertising information as a

substitute (Column 15, lines 31-34) for the original information in the recorded program

stored in the storage means (Column 7, lines 10-11, 13-20, Column 15, lines 31-34,

Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the combination to include second storage

means for storing customized program content (Figure 5, 86, Column 13, lines 38-57,

Column 15, lines 25-30); user information management means for storing user

information about each requesting origin (Figure 5, 82), and obtaining advertising

information appropriate for a user attribute of the requesting origin from another external

device or advertising source via the wide area network by the connection means (Figure

5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9,

lines 39-55) and the recording substitution means or ad insertion device (Figure 5, 80,

86, 83, 82, 81) configured to one of a) stores a recorded program in the first storage

means (Column 14, lines 9-11) and the advertising information in the second storage

means (Figure 5, 82), the advertising information stored as an insert in the recorded
program in addition to original commercial information included in the recorded program
as only obsolete ads will be replaced (Column 14, lines 1-12) and b) stores the recorded
program stored in the first storage means (Column 14, lines 9-11) and the advertising
information as a substitute (Column 15, lines 31-34) for the original information in the
recorded program stored in the storage means (Column 7, lines 10-11, 13-20, Column
15, lines 31-34, Column 14, lines 1-12) as taught by Zigmond in order to provide
advertisements that are more interesting to the viewer for premium payment from the
advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in
the prior art then one skilled in the art could have combined the elements as claimed by
known methods with no change in their respective functions, and the combination would
have yield predictable results to one of ordinary skill in the art at the time of the
invention. *KSR*, 82 USPQ2d at 1395.

Regarding Claim 5, Kuroda, Ellis and Zigmond disclose all the limitations of
Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video
recorder may store signals via World Wide Web in the temporary storage device
(Column 12, lines 28-44). It is noted that the World Wide Web records data from a
plurality of external devices (plurality of users) and the substitution means is located
upstream from the user and records program per users' requests.

Regarding Claim 6, Kuroda, Ellis and Zigmond disclose all the limitations of

Claim 4. Kuroda discloses comprising user information management means for storing

user information about each requesting origin, wherein the recording substitution means

records a broadcast program in a format appropriate for a user attribute of the

requesting origin including HDD format, DVD format or VCR format (Figure 1, 105,

Figure 7, Figure 22).

Regarding Claim 9, Kuroda disclose a recording substitution system for

substitutionally recording a program (Figure 1), comprising:

receiving portion configured to receive a program (Figure 1, Figure 2);

a first storage portion configured to record a program (Column 4, lines 18-50,

Figure 2, 103, 105);

connection portion configured to connect with external devices (Column 4, lines

38-44, Column 5, lines 60-65);

recording substitution portion configured to respond to the reception of a

recording substitution request from at least one of the external devices via the

connection means for receiving and recording means for issuing a recording substitution

request to an external device for recording the program via the connection portion

(Figure 22, Figure 7).

Kuroda discloses recording substitution means or the recorder/player for

responding to reception of a recording substitution request via connection means and

receiving and recording a corresponding in the storage means (Column 5, lines 60-65,

Figure 7). Kuroda discloses the recording system or recording substitution system

receives and records television programs in the storage means or the external device,

which necessarily includes commercials.

Kuroda is silent for a second storage portion configured to store customized

program content; connection portion for connecting via a wide area network with

external devices, means for responding to reception of a recording request from at least

one of the external devices via connection means for receiving and recording the

program via the wide network by the connection means. Kuroda is silent on recording

substitution means is configured to one of a) stores the new advertising content,

received from another external device, in the storage portion as a replacement for

advertising content in the recorded program stored in the storage portion and b) store

additional advertising content, received from the another external device, in the storage

portion as an insert in the recorded program stored in the storage portion.

In analogous art, Ellis discloses means for accepting a request to record and/or

reserve a program (Page 6, paragraph 0084-0086, Figure 5); local storage means for

recording the program (Page 6, paragraph 0086, Figure 7, 32, 31, 29); connection

means for connecting via a wide area network with external devices which is external to

the recording system including remote media server for recording programs, television

distribution facility for distributing television, program, advertisements, video and/or

program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-

0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from

at least one of the external devices via connection means for receiving and recording

the program via the wide network by the connection means and for receiving and

recording a program corresponding to the request in the storage means (Page 6,

paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Kuroda to include connection portion for

connecting via a wide area network with external devices which is external to the

recording system including remote media server for recording programs, television

distribution facility for distributing television, program, advertisements, video and/or

program guide data (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-

0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from

at least one of the external devices via connection means (Page 6, paragraphs 0084-

0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20) as taught by Ellis in order to

provide make it convenient for users to play programs on demand instead of the users

having to wait for a previously scheduled program to possibly repeat at a time

scheduled by the provider (Page 1, paragraphs 0009-0011) as disclosed by Ellis.

The combination is silent on second storage means for storing customized

program content; and the recording substitution means or ad insertion device configured

to one of is configured to one of a) store a recorded program in the first storage means

and the new advertising content, received from another external device, as a

replacement for advertising content in the recorded program stored in the storage and

b) store the recorded program stored in the first storage portion and additional

advertising content, received from the another external device, in the second storage

portion, the additional advertising content stored as an insert in the recorded.

        In analogous art, Zigmond discloses connection means to external devices

(Figure 4, 62, 66, Column 9, lines 39-55); first storage means for recording the program

(Column 14, lines 9-11); second storage means for storing customized program content

(Figure 5, 86, Column 13, lines 38-57, Column 15, lines 25-30); user information

management means for storing user information about each requesting origin (Figure 5,

82), and obtaining advertising information appropriate for a user attribute of the

requesting origin from another external device or advertising source via the wide area

network by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11,

lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55, Column 14, lines 4-6) and the

recording substitution means or ad insertion device (Figure 5, 80, 86, 83, 82, 81).

Zigmond discloses recording substitution portion (ad insertion device performing ad

insertion via repository and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) is

configured to one of a) store a recorded program in the first storage means (Column 14,

lines 9-11) and the new advertising content (in the advertisement repository) Column

15, lines 31-34), received from another external device (Figure 4, 62), as a replacement

for advertising content in the recorded program stored in the storage portion (Column

15, lines 30-33, Column 7, lines 10-11, 13-20, Column 15, lines 31-34, Column 14, lines

1-12) and b) store the recorded program stored in the first storage portion and additional

advertising content, received from the another external device, in the second storage

portion, the additional advertising content stored as an insert in the recorded program

as only obsolete ads will be replaced (Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the combination to include second storage

means for storing customized program content (Figure 5, 86, Column 13, lines 38-57,

Column 15, lines 25-30); recording substitution portion (Figure 1, 85, Column 15, lines

24-27, 31-34) is configured to one of) store a recorded program in the first storage

means (Column 14, lines 9-11) and the new advertising content (in the advertisement

repository) Column 15, lines 31-34), received from another external device (Figure 4,

62), as a replacement for advertising content in the recorded program stored in the

storage portion (Column 15, lines 30-33, Column 7, lines 10-11, 13-20, Column 15, lines

31-34, Column 14, lines 1-12) and b) store the recorded program stored in the first

storage portion and additional advertising content, received from the another external

device, in the second storage portion, the additional advertising content stored as an

insert in the recorded program as only obsolete ads will be replaced (Column 14, lines

1-12) as taught by Zigmond in order to provide advertisements that are more interesting

to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as

disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in

the prior art then one skilled in the art could have combined the elements as claimed by

known methods with no change in their respective functions, and the combination would

have yield predictable results to one of ordinary skill in the art at the time of the

invention. *KSR*, 82 USPQ2d at 1395.

10.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in

view of Lawler et al (US 5,805,763 and hereafter referred to as "Lawler").

        Regarding Claim 8, Kuroda disclose a recording system for recording and/or

reserving a program (Figure 1) and a recording substitution system for substitutionally

recording a program (Figure 1, Figure 2), comprising: a request accept portion

configured to accept a request to record and/or reserve a program (Column 4, lines 18-

50); local storage portion for recording a program (Column 4, lines 18-50, Figure 2, 103,

105, Figure 9, 812); connection portion for connecting with an external device (Column

4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure

2); determination portion for determining a failure in the recording system in or based on

lack of storage space the storage means fails to record the program requested to be

recorded and/or reserved (Column 5, lines 60-65); means for automatically issuing a

recording substitution request to the external device for recording the program via the

connection means in response to the determination portion determining the failure

(Figure 22, Figure 7). Kuroda discloses recording substitution means or the

recorder/player for responding to reception of a recording substitution request via

connection means and receiving and recording a corresponding in the storage means

(Column 5, lines 60-65, Figure 7). Kuroda discloses that external storage devices can

be numerous external storage devices (Figure 2, 105, Figure 9, 821-823, Column 8,

lines 25-32). Kuroda discloses if a user selects a program to be recorded and the local

storage device runs out of space, the program is automatically not deleted by being

moved to the external storage device (Figure 22, Column 12, lines 16-24). Therefore,

Kuroda does not explicitly disclose automatically issuing recording request to an

external storage device. Kuroda is silent for connection means for connecting via a

wide area network with an external storage device which is external to the recording

system, issue portion automatically issuing a recording request to the external storage

device for recording the program via the wide network by the connection means.

In analogous art, Lawler discloses means for accepting a request to record

and/or reserve a program (Column 12, lines 29-31, 58-61); local storage means for

recording the program (Figure 2, 23); connection means for connecting via a wide area

network with an external storage device which is external to the recording system

(Column 5, lines 28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12,

26-36), issue portion for automatically issuing a recording request to the external

storage device for recording the program via the wide network by the connection means

(Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36). Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to

modify Kuroda to include means for accepting a request to record and/or reserve a

program (Column 12, lines 29-31, 58-61); local storage means for recording the

program (Figure 2, 23); connection means for connecting via a wide area network with

an external storage device which is external to the recording system (Column 5, lines

28-31, Figure 1, 14, Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36), issue

portion for automatically issuing a recording request to the external storage device for

recording the program via the wide network by the connection means (Column 12, lines

29-31, 58-61, Column 13, 8-12, 26-36) as taught by Lawler in order to provide allow

users to access a single recorded program (Column 13, 8-12, 26-36) as disclosed by

Lawler.

Furthermore, the *KSR* Court found that if all the claimed elements are known in

the prior art then one skilled in the art could have combined the elements as claimed by

known methods with no change in their respective functions, and the combination would

have yield predictable results to one of ordinary skill in the art at the time of the

invention. *KSR*, 82 USPQ2d at 1395.

11.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda

in view of Ellis, as applied to Claim 1, further in view of Zigmond.

Regarding Claim 10, Kuroda and Ellis disclose all the limitations of Claim 1

Kuroda discloses receiving and recording television programs in the storage means or

the external device, which necessarily includes commercials. Ellis discloses connection

means for connecting via a wide area network with external devices which is external to

the recording system (Page 3, paragraph 0060, Page 4, paragraph 0064, 0066, 0069-

0070, Figure 2c, 61, 24, Figure 2d, 61, 24), means for issuing a recording request from

at least one of the external devices via connection means for receiving and recording

the program via the wide network by the connection means and for receiving and

recording a program corresponding to the request in the storage means (Page 6,

paragraphs 0084-0086, Page 4, paragraphs 0065, Figures 2c, 2d, 24, 20). Ellis

discloses external device includes user information management means (Page 6,

paragraph 0082). Kuroda and Ellis is silent on a recording medium obtaining

advertising information appropriate for a user attribute of the requesting origin via the

connection means and one of a) inserts the advertising information in a recorded

program stored in the storage means in addition to original commercial information

included in the recorded program and b) substitutes the advertising information for the

original information in the recorded program.

In analogous art, Zigmond discloses any recording medium comprising recording

substitution means obtaining advertising information appropriate for a user attribute of

the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12,

Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55). Zigmond discloses

recording substitution means (ad insertion device performing ad insertion via repository

and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a)

inserts the advertising information in a recorded program in addition to original

commercial information or any commercials that an advertiser can specify to be shown

during a particular program and only some commercials have to be replaced in a

recorded program so inserting new commercials to original commercials with the

recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the

recorded program interpreted which is met by some commercials or advertisements are

overwritten based on timewise data (Column 14, lines 1-12) and b) replacing or

substituting for the original commercial information included in the recorded program

(Column 14, lines 1-12). Therefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to combine Zigmond to include any recording medium comprising recording substitution means obtaining advertising information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55) and one of a) inserting into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program included in the recorded program some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12, Column 12, lines 54-9) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12) to the external device (any recording medium) of the combination of Ellis and Kuroda in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

12.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Lawler as applied to Claim 8, further in view of Zigmond.

Regarding Claim 11, Kuroda and Lawler disclose all the limitations of Claim 8.

Kuroda discloses receiving and recording television programs in the storage means or

the external device, which necessarily includes commercials. Lawler discloses

connection means for connecting via a wide area network with an external storage

device which is external to the recording system (Column 5, lines 28-31, Figure 1, 14,

Column 12, lines 29-31, 58-61, Column 13, 8-12, 26-36), issue portion for issuing a

recording request to the external storage device for recording the program via the wide

network by the connection means (Column 12, lines 29-31, 58-61, Column 13, lines 8-

12, 26-36). Lawler discloses external device includes user information management

means (Column 13, lines 8-12, 26-36). Kuroda and Lawler is silent on a recording

medium obtaining advertising information appropriate for a user attribute of the

requesting origin via the connection means and one of a) inserts the advertising

information in a recorded program stored in the storage means in addition to original

commercial information included in the recorded program and b) substitutes the

advertising information for the original information in the recorded program.

In analogous art, Zigmond discloses any recording medium comprising recording

substitution means obtaining advertising information appropriate for a user attribute of

the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12,

Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55). Zigmond discloses

recording substitution means (ad insertion device performing ad insertion via repository

and switching unit) (Figure 5, Column 15, lines 24-27, 31-34) configured to one of a)

inserting the advertising information in a recorded program in addition to original

commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Zigmond to include any recording medium comprising recording substitution means obtaining advertising information appropriate for a user attribute of the requesting origin by the connection means (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65, Figure 4, 62, 66, Column 9, lines 39-55) and one of a) inserting into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program included in the recorded program some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12, Column 12, lines 54-9) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12) to the external device (any recording medium) of the combination of Lawler and Kuroda in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. *KSR*, 82 USPQ2d at 1395.

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/FARZANA HOSSAIN/
Examiner, Art Unit 2424

December 23 2009